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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,221	07/23/2001	Yasuo Matsuzawa	CL/V-31333P1	4909
1095	7590	07/06/2004	EXAMINER	
NOVARTIS CORPORATE INTELLECTUAL PROPERTY ONE HEALTH PLAZA 430/2 EAST HANOVER, NJ 07936-1080			MOORE, KARLA A	
			ART UNIT	PAPER NUMBER
			1763	

DATE MAILED: 07/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/911,221

Applicant(s)

MATSUZAWA ET AL.

Examiner

Karla Moore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24, 34 and 36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17-24 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 12-16, 34 and 36 is/are rejected.
- 7) ☒ Claim(s) 3-11 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 0504.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Specification***

2. The abstract of the disclosure is objected to because it is too long. Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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5. Claims 1-2, 12-16, 34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,016,562 to Madan et al. in view of U.S. Patent No. 4,920,917 to Nakatani et al. and U.S. Patent No. 5,695,564 to Imahashi.

6. Madan et al. disclose a system capable of treating the surface of an optical lens substantially as claimed, said system comprising: an entry chamber (Figure 2, 20) having a first entrance gate (44-fourth gate from left) and a first exit gate (44, sixth gate from left), said first entrance gate and said first exit gate are capable of sealing said entry chamber including a conveyor/means for conveying (34) extending between said first entrance gate and said first exit gate; a negative pressure source/means for selectively applying negative pressure (58) in selective communication with said entry chamber; a coating chamber (22) having a second entrance gate (44, sixth gate from left) and a second exit gate (44, seventh gate from left), said second entrance gate and said second exit gate are capable of sealing said coating chamber when closed, said coating chamber including a conveyor /means for conveying (34) extending between said second entrance gate and said second exit gate so that said conveyor is capable of conveying a lens; a source of plasma gas/means for introducing a plasma gas (50) in communication with said coating chamber to introduce said gas into said coating chamber; a second negative pressure source/means for selectively applying a negative pressure (column 7, rows 38-41) in communication with said coating chamber; an exit chamber (24) having a third entrance gate (44, seventh gate from left) and a third exit gate (ninth gate from left), said third entrance gate and said third exit gate are capable of sealing said exit chamber when closed and said exit chamber including a conveyor/means for conveying (34) extending between said third entrance gate and said third exit gate; and a negative pressure source/means for selectively applying negative pressure (58) in selective communication with said exit chamber, wherein said entry chamber communicates with said coating chamber through said first exit gate and said second entrance gate so that said entry chamber conveyor and said coating chamber conveyor are capable of communicating to pass a lens from said entry chamber to said coating chamber, and wherein said coating chamber communicates with said exit chamber through said exit gate so that said coating chamber conveyor and said exit chamber conveyor are capable of communicating to pass a lens from said coating chamber to said exit chamber. The coating chamber is fully disclosed as being

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capable of decomposing a gas using glow discharge (i.e. the chamber is capable of plasma processing).

See column 7, rows 15-25.

7. However, Madan et al. fail to explicitly teach said coating chamber including at least *a pair of spaced apart electrodes/means for maintaining a plasma cloud of said gas* disposed therein so that said conveyor is capable of conveying a lens between said electrodes and *an electrical power source* in communication with said electrodes to apply a predetermined electrical potential at each said electrode so that, upon establishment of a predetermined pressure in said coating chamber by said second negative pressure source, a plasma cloud of gas is established between said electrodes. Nor do Madan et al. teach separate negative pressure sources for the entrance and exit chambers.

8. Nakatani et al. disclose a plasma coating chamber including at least a pair of spaced apart electrodes (Figure 1, 4 and 5) disposed therein and an electrical power source (10) in communication with said electrodes to apply a predetermined electrical potential at each electrode so that a plasma cloud of gas is established between said electrodes (column 3, rows 42-54; column 8, rows 40-44). The electrodes and electrical power source are provided for the purpose of creating an electric discharge in a reaction chamber while a substrate is being moved from one end of a chamber to another and for the purpose of supplying power between the opposite electrodes to excite the reaction gas to a plasma state.

9. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to have provided spaced apart electrodes and an electrical power source in Madan et al. in order to provide the plasma discharge, which is not specifically described in Madan et al., as taught by Nakatani et al.

10. Madan et al. further fails to teach each of the entry and exit chambers connected to separate negative pressure sources.

11. Imahashi teaches the use of separate vacuum exhaust systems for each unit in a multi-chamber processing apparatus for the purpose of providing the capability of individually making each unit have a predetermined pressure (column 4, rows 59-67 and column 5, rows 23-33).

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12. It would have been obvious to one of ordinary skill in the art at the time the Applicant's invention was made to have provided separate vacuum exhaust systems for each units in the multi-chamber apparatus of Madan et al. in order to provide the capability of individually making each unit have a predetermined negative pressure atmosphere.

13. With respect to claim 2, which is drawn to a material used in an intended method the apparatus is capable of performing, the courts have ruled that expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. Ex parte Thibault, 164 USPQ 666, 667 (Bd. App. 1969).

14. With respect to claims 12 and 13, the courts have ruled that the mere duplication of parts has no patentable significance unless a new and unexpected result is produced. In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). Further, with respect to claim 13, it would have been obvious to one of ordinary skill in the art that in order to form a discharge a source of plasma gas would need to be proximate the electrodes.

15. With respect to claim 14, the coating chamber contains a second negative pressure source, as note above, that would be "proximate" any electrodes in the chamber as the chamber is not that large.

16. With respect to claim 15, Nakatani et al. further teach the use of an entry buffer area (13) upstream from said electrodes and an exit buffer area (13) downstream from said electrodes in order to provide gas isolation (column 8, rows 39 and 40).

17. With respect to claim 16, the first exit gate and second entrance gate comprise a single gate and said second exit gate and said third entrance gate comprise a single gate. See Figure 2 of Madan et al.

18. With respect to claim 36, Madan et al. further discloses a control system in communication with said negative pressure source, said entry chamber, said coating chamber, said exit chamber and said conveyor, said control system configured to move said lens through each said chamber by said conveyor, to selectively seal said entry chamber from said coating chamber and said exit chamber from said coating chamber and to selectively pressurize and depressurize said entry chamber and said exit chamber (column 7 row 47 through column 8, row 27).

***Allowable Subject Matter***

19. Claims 3-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

20. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record fails to teach or fairly suggest either the entry hold chamber (claim 3) or the exit hold chamber (claim 6) in communication with a source of plasma gas. Nor does the prior art teach or fairly suggest a drying chamber upstream from said entry chamber (claim 9). The prior art also further fails to teach or fairly suggest the claimed, detailed sequence of events that the controller is configured to execute (claim 11).

21. Claims 17-24 allowed.

22. The following is an examiner's statement of reasons for allowance: The prior art of record fails to teach or fairly suggest either the entry chamber or the exit chamber in communication with a source of plasma gas (claim 17). Nor does the prior art of record teach or fairly suggest a source of plasma gas in selective communication with each of said entry hold chamber, said entry buffer chamber, said coating chamber, said exit buffer chamber and said exit chamber (claim 19)

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karla Moore whose telephone number is 571.272.1440. The examiner can normally be reached on Monday-Friday, 8:30am-5:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Mills can be reached on 571.272.1439. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

km  
24 June 2004

*P. Hassanzadeh*  
Parviz Hassanzadeh  
Primary Examiner  
Art Unit 1763